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on January 9, 2008

TOWNSEND and TOWNSEND and CREW LLP

By: Patricia Anders

PATENT  
Attorney Docket No.: 022101-000700US  
Client Ref. No.: 18500-US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Waltraud ANKENBAUER, et al.

Application No.: 09/269,860

Filed: March 10, 2000

For: THERMOSTABLE NUCLEIC  
ACID POLYMERASE FROM  
THERMOCOCCUS GORGONARIUS

Customer No.: 41504

Confirmation No. 1720

Examiner: R. Hutson

Technology Center/Art Unit: 1652

RENEWED PETITION UNDER 37 CFR  
1.137(b)

Mail Stop PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Examiner Hicks:

In response to the Decision on Petition mailed September 18, 2007, Applicants request entry and consideration of the following remarks. A petition for a two-month extension of time for response, from November 18, 2007 through January 18, 2008, accompanies this Petition.

**REMARKS/ARGUMENTS**

This letter, and the accompanying Exhibits and Declarations of Winsome St. Rose and George C. Jen are filed in response to the Decision on Petition mailed on September 18, 2007.

Applicants hereby renew the Petition to Revive the above-identified application under 37 CFR 1.137(b). The application became unintentionally abandoned on May 16, 2002 for failure to pay the issue fee in response to a Notice of Allowance mailed on January 9, 2002.

The Decision on Petition indicated that the previously-filed petition to revive lacked (A) the required reply to the Notice of Allowance (specifically, formal drawings) and (B) a statement that the entire period of delay in filing the required reply from the due date of the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional.

A fee for revival under 35 U.S.C. § 41(a)(7) was previously paid with the petition mailed on November 10, 2006. Therefore, no further fees are required aside from the extension fee discussed above. However, if further fees are due, Applicants hereby authorize the Patent Office to charge such fees to Deposit Account No. 20-1430.

***A. Required Reply to Notice of Allowance***

The Decision on Petition noted that the original petition to revive provided the required issue fee, but did not include the formal drawings requested with the Notice of Allowance. The requested formal drawings are included herein, and the Patent Office is hereby requested to replace the relevant drawings of the patent application with those enclosed.

***B. The Entire Time Period was Unintentional***

The Decision on Petition stated that the original Petition to Revive did not provide a statement that the entire period of delay in filing the required reply from the due date of the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. *See*, Decision on Petition, pages 1-2. It should be noted that the original petition included the statement: "The entire delay in filing the requested reply from the due date from the required reply until the filing of a grantable petition under 37 C.F.R. §1.137(b) was unintentional."

Apparently, however, the Office of Petitions requires additional detail regarding the unintentional abandonment before the petition can be granted.

As discussed in more detail below, and evidenced by the declarations of Winsome St. Rose and George C. Jen (attached), the failure to respond to the Notice of Allowance was unintentional. Furthermore, the entire delay from the time of abandonment on May 16, 2002, until the filing of the Petition to Revive on November 10, 2006, was unintentional. Finally, any delay from the mailing of the Decision on Petition, on September 18, 2007, until the filing of the present Renewed Petition was unintentional.

The case law cited in the Decision on Petition can be distinguished from the facts in the present case. Importantly, in each of the cited cases there was some indicia that the Applicants were on notice of the abandoned status of the application, or were aware of an impending deadline that if missed would result in abandonment. The present case is factually very different from these cases because, as detailed below, no one involved in the prosecution of the application was aware that a Notice of Allowance or Notice of Abandonment had been mailed and did not become aware of the abandonment until years later.

*i. The Delay In Reply That Originally Resulted In Abandonment Was Unintentional*

The present application has an extremely complicated history involving different subsidiaries of the parent company Hoffman-La Roche, and different law firms, one of which (Pennie and Edmonds) is no longer in existence. Briefly, as discussed in more detail below, the inventors and the assignee for this application are located in Germany (Roche Diagnostics GmbH, Mannheim, Germany), while the in house counsel and persons primarily responsible for the prosecution of the application were employed by Roche Molecular Systems (RMS) Alameda, CA, USA, a different subsidiary of the parent company Hoffman La Roche. Due to a high turnover of personnel in the Patent Department at RMS, responsibility for prosecuting the application was given to an outside law firm, Pennie and Edmonds. Following dissolution of Pennie and Edmonds as a law firm, the files for the application (which was believed by both RMS and Pennie and Edmonds to be pending) were transferred to a new outside counsel,

Townsend and Townsend and Crew LLP. Thus, the present case involves multiple persons employed by different subsidiaries, on different continents, and members of multiple law firms.

The delay in reply that originally resulted in abandonment of the patent application in question was unintentional. A Notice of Allowance was mailed on January 9, 2002. There is no record, however, of RMS having ever received the Notice of Allowance or the Notice of Abandonment. *See*, Declaration of Winsome St. Rose, paragraph 8, and Declaration of George C. Jen, paragraphs 3-4. The Notice of Allowance was never received by the appropriate personnel at RMS because the Patent Office mailed the Notice of Allowance (and later, the Notice of Abandonment) to Douglas Petry in spite of repeated attempts by Mr. Petry to change the correspondence address used by the Patent Office for this patent application. To assist the Office of Petitions in understanding the events surrounding this application, a timeline of the relevant events in the file history is attached as Exhibit (A).

As shown in the timeline, Douglas Petry, along with Joseph Kirk, and Dennis Tramaloni, were originally granted power of attorney for the application on April 1, 1999. On July 30, 1999, Douglas Petry filed the first of three Change of correspondence address forms, requesting that the correspondence address be changed to Customer No. 22829, *i.e.*, to the Patent Department at RMS. *See*, Exhibit (B). The Patent Office never acknowledged that correspondence.

On March 6, 2000, Douglas Petry filed the second of three Change of Correspondence Address forms, and a Power of Attorney granting Associate Power of Attorney to Victor K. Lee, and requesting that the correspondence be addressed to Victor Lee of RMS. *See*, Exhibit (C). The Patent Office never acknowledged that correspondence.

On February 13, 2001, Douglas Petry filed the third of three Change of Correspondence Address forms, requesting that the correspondence address be changed to customer No. 22829 *See*, Exhibit (D). The Patent Office never acknowledged that correspondence.

Furthermore, in addition to the three Change of Correspondence Address forms discussed above, Change of Power of Attorney forms filed on March 6, 2000, December 13, 2001 and October 4, 2004, were never acknowledged by the Patent Office. Indeed, the only

Change of Power of Attorney form acknowledged by the Patent Office was the form filed on August 16, 2006.

Douglas Petry left the employment of RMS on July 21, 2001 (*see*, Declaration of Winsome St. Rose, paragraph 11).

In spite of the three request for Change of Correspondence Address from Douglas Petry, the Patent Office mailed the Notice of Allowance to Douglas Petry on January 9, 2002. There is no evidence in the internal RMS file that RMS ever received the Notice of Allowance, or the subsequent Notice of Abandonment. *See*, Declaration of Winsome St. Rose, paragraph 8.

As further evidence that the no one in the Patent Department at RMS was aware of the Notice of Allowance (or the subsequent Notice of Abandonment), the declaration of George C. Jen is provided. George C. Jen was head of the patent department at RMS during the time the Notice of Allowance and Notice of Abandonment were mailed, and was listed on the power of attorney form faxed to the Patent Office on December 13, 2001, which was never acknowledged by the Patent Office. *See*, Exhibit (E). During this time, it was standard practice at RMS to forward all Patent Office correspondence to Pennie & Edmonds for docketing. *See*, Declaration of George C. Jen, paragraph 4. As explained in the Declaration of George C. Jen, Mr. Jen relied on RMS's then-outside counsel, Pennie & Edmonds, to provide docket status reports. *See*, Declaration of George C. Jen, Paragraph 4. Exhibits F and G, as referred to in Paragraph 4 of the Declaration of George C. Jen, are redacted versions of exemplary docket status reports from Pennie and Edmonds. These redacted docket reports from Pennie and Edmonds, dated after mailing of the Notice of Allowance and the Notice of Abandonment continued to state that the application was "pending," indicating that neither RMS nor Pennie and Edmonds was aware of the Notice of Allowance or Notice of Abandonment.

In short, the Patent Office mailed both the Notice of Allowance and Notice of Abandonment to an incorrect addressee in spite of repeated efforts by RMS to have correspondence sent to a different addressee. As a result, no one in the Patent Department of RMS, nor RMS's outside counsel, were aware of either Notice until well after the application had gone abandoned.

Accordingly, the delay in reply that originally resulted in abandonment of the patent application in question was unintentional.

*ii. The Delay In Filing an Initial Petition Pursuant To 37 CFR 1.137(b) To Revive The Application Was Unintentional*

As explained above, RMS does not have any record of ever receiving the Notice of Allowance or Notice of Abandonment. Thus, well after the Notice of Abandonment was mailed, RMS continued to be under the impression that the application was pending. As delays from the Patent Office were not unusual, silence from the Patent Office was not interpreted as a problem with the patent application.

RMS's lack of knowledge of the abandonment of the application is reflected in the reports and filings made by RMS after the Notice of Abandonment was mailed. For example, a listing of the status of RMS applications created on or around January 26, 2004 indicated that the status of the application was "Pending." *See*, Exhibit (H) and Declaration of Winsome St. Rose, paragraph 29.

Further, on August 20, 2004, RMS filed an assignment for the patent application *See*, Exhibit (I). A Power of Attorney form was filed with the Patent Office on October 4, 2004. *See*, Exhibit (J). If RMS had known the application was abandoned, there would have been no reason to file these documents. On September 3, 2004, the Patent Office sent a Notice of Recordation of the assignment, but did not acknowledge the Change of Correspondence Address, nor mention that the application was abandoned. *See*, Exhibit (K). Thus, correspondence to and from the Patent Office did not indicate the application was abandoned in late 2004.

On October 11, 2005, a paralegal at Townsend and Townsend and Crew LLP ("Townsend") performed a status check on PAIRS to determine the status of the application. The status of the application was noted as being abandoned. However, there is no evidence that this was communicated to the patent department at RMS.

On January 6, 2006 the Patent Office again communicated directly to RMS and noted that the customer number change requested in August 20, 2004 had been processed. This

communication is notable for at least two reasons. First, the communication from the Patent Office was sent almost a year and a half after the simple request for change of correspondence address had been made by RMS. This is evidence of the types of delay experienced by RMS with the Patent Office and shows it was reasonable for RMS to assume that the application was pending and simply delayed in the Patent Office. Second, the communication from the Patent Office is also notable because there is no mention that the application was abandoned.

On or around June 2005, this application was listed as part of a settlement between Hoffman-La Roche (the parent company of Roche Diagnostics GmbH and RMS) and another entity. *See*, Declaration of Winsome St. Rose, paragraph 36. That event sparked a renewed interest in the status of the case, prompting RMS to more actively investigate the nature of the delay in prosecuting the application by the Patent Office. In January, 2006 RMS attempted to check PAIRS to confirm the status of the application. However, RMS was denied access to the records due to a lack of the appropriate power of attorney information. RMS was refused access in spite of the October 4, 2004 request by RMS to the Patent Office to update the Power of Attorney for RMS and to apply Customer number 41504 (a shared customer number between members of the RMS Patent Department and attorneys at Townsend and Townsend and Crew LLP). It was assumed that during the period from January 2006, until August 2006, that the application was still pending and arrangements were being made to gain access to the file.

At least in October of 2005, when the status of the application was checked by the paralegal at Townsend and Townsend and Crew LLP, an electronic copy of the file history was not available on PAIR. In an effort to gain access to the file, on August 16, 2006 RMS filed yet another Revocation and Substitute Power of Attorney, appointing Customer number 22829, and simultaneously granted Landon IP Inc. power to inspect the files. *See*, Exhibit (L). RMS filed this Power of Attorney to obtain a copy of the file history from the Patent Office. Landon IP Inc. subsequently obtained a hard copy of the file history directly from the Patent Office and forwarded the copy to RMS in September 2006. The abandoned status of the application was discovered on or about August 24, 2006, and a copy of the file history was delivered to RMS in September 2006. A petition to revive the application was filed on November 10, 2006.

In sum, the entire delay in filing the initial petition pursuant to 37 CFR 1.137(b) to revive the application was unintentional. Once members of the Patent Department of RMS understood that application was abandoned, and learned from the file history why exactly abandonment occurred, a petition to revive the application was filed quickly. There is no evidence that RMS ever intended for the application to become abandoned or knew for several years after the abandonment that the application was in fact abandoned.

*i. The Delay In Filing A Grantable Petition Pursuant To 37 CFR 1.137(b)  
To Revive The Application Was Unintentional*

Following receipt of the Decision on Petition, a detailed analysis of the facts was made to provide the details submitted in this renewed petition. Further, one of the main Declarants (Winsome St. Rose) was not available for the full time after the Decision on Petition was received due to several different, previously planned, absences from work, including a trip to Europe. Further, the Thanksgiving and Christmas holidays also interfered with the preparation of this renewed petition. Therefore, the delay in filing this grantable petition was unintentional.

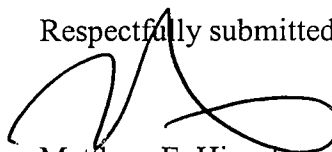


**CONCLUSION**

In view of the foregoing, Applicants believe the entire delay in filing the requested reply from the due date from the required reply until the filing of a grantable petition under 37 C.F.R. §1.137(b) was unintentional. Reconsideration and grant of this petition is respectfully requested.

If the Office of Petitions believes a telephone conference would expedite consideration of this Petition, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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